REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed August 12, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(e)

Claims 1, 2, 13-15, 18, 19, and 28 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Lin (U.S. Pub. No. 2003/0052897). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e). In the present case, not every feature of the claimed invention is represented in the Lin reference. Applicant discusses Applicant's claims in relation to the Lin reference in the following.

Applicant claims programs, systems, and methods for creating a multimedia presentation. For example, as provided in independent claims 1, 14, and 18, Applicant claims (emphasis added):

> 1. A computer-readable medium having a program for composing a multimedia presentation from a plurality of media elements, the plurality of media elements including audio media elements and image elements, the image elements including at least one still image, ***the program comprising logic configured to***:

determine at least one control setting, the control setting including the duration time for display of the at least one still image in an initial presentation; and

automatically compose the initial presentation, the initial presentation including the plurality of media elements, the initial presentation based in part on the duration time for the at least one still image and the initial presentation ***based in part on at least one time stamp associated with at least one of the media elements.***

14. A system for composing a multimedia presentation from a plurality of media elements, the plurality of media elements including audio elements, the plurality of media elements including image elements, the image elements including at least one still image, the system comprising:

means for determining at least one control setting, the control setting including the duration time for the at least one still image;

means for automatically composing an initial presentation, the initial presentation including the plurality of media elements, the initial presentation based in part on the duration time for the at least one still image and ***based in part on the time of recording of the plurality of media elements.***

18. A method for creating a multimedia presentation from a plurality of media elements, the plurality of media elements including audio elements and image elements, the image elements including at least one still image, the method comprising:

determining at least one control setting, the control setting including the duration time for the at least one still image; and

automatically composing an initial presentation, the initial presentation including the plurality of media elements, the initial presentation ***based in part*** on the duration time for the at least one still image and in part ***on the time of recording of the plurality of media elements.***

Applicant notes that Lin does not disclose any program, system, or method that automatically composes an initial presentation. To the contrary, Lin appears to disclose a system in which the user must make all media selections, for example using a name created for "picture units." For instance, Lin states under the "DVD Photo Album" portion of the disclosure (emphasis added):

> Each VOBS 30 can include one or more video objects (VOB) 32. For purposes of the invention, each VOB 32 can be referred to as a picture group (PG). In one arrangement, each VOB 32 can have a menu for PG 33, which can list all the cells 34 that are contained within a particular VOB 32. For purposes of the invention, each cell 34 can be referred to as a picture set (PS). Similar to the VOB's 32, each cell 34 can have a menu for PS 35, which can list all the picture units (PU) 37 contained within a particular cell 34. ***These PU's 37 can be listed in the menu for PS 35 according to the name created for each particular PU 37 during the writing process as discussed in FIG. 1.*** As a result, a user is permitted direct access to any PU 37 that is stored on the disc 102 as part of a DVD photo album and is not limited to access data at the cell 34 layer.

From the above, it is clear that nothing in the Lin system automatically composes an initial presentation. Accordingly, Lin fails to teach or suggest any of "logic configured to . . . automatically compose an initial presentation" as provided in claim 1, "means for automatically composing an initial presentation" as provided in claim 14, or "automatically composing an initial presentation" as provided in claim 18.

As a further point, Applicant notes that Lin does not compose an initial presentation that is based in part on the time of recording of the plurality of media. Although Lin makes a brief reference to "when the file was created" (Lin, paragraph

0056, lines 7-10), *nowhere* does Lin state that such a time is used as a basis for composing a presentation. Accordingly, Lin fails to teach or suggest composing an initial presentation "based in part on at least one time stamp associated with the at least one of the media elements" as provided in claim 1, "based in part on the time of recording of the plurality of media elements" as provided in claim 14, or "based . . . in part on the time of recording of the plurality of media elements" as provided in claim 18.

Due to the shortcomings of the Lin reference described in the foregoing, Applicant respectfully asserts that Lin does not anticipate Applicant's claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

Claims 3-12, 16, 17, 20-27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin. Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

> motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

As an initial matter, Applicant refers to the discussion of the Lin reference provided above in relation to the rejection under 35 U.S.C. § 102(e). In view of the deficiencies of the Lin reference identified in that discussion, Applicant's claims are allowable over Lin under 35 U.S.C. § 103 for at least the same reasons as those discussed in the foregoing.

With particular regard to the statement of the rejection under 35 U.S.C. § 103, the Examiner has taken official notice of various claim limitations. The MPEP defines the standard for taking official notice. As is provided in MPEP § 2144.03:

> Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such

instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

As is provided in MPEP § 2144.03 (emphasis added):

> If applicant adequately traverses the examiner's assertion of official notice, ***the examiner must provide documentary evidence in the next Office action*** if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

In the instant case, Applicant respectfully submits that displaying an image line or an audio line that comprises a "graphical depiction showing the order" is not known so as to be capable of instant and unquestionable demonstration. Specifically, although thumbnails of slideshow presentations are known, such a collection of thumbnails does not comprise a "graphical depiction" as recited in Applicant's claims and described in Applicant's specification. Accordingly, Applicant traverses the Examiner's use of official notice. Because of this traversal, the Examiner must support his finding with documenting evidence (e.g., an art reference or affidavit), or withdraw the official notice determination.

In view of the above, it is Applicant's position that Applicant's claims are patentable over Lin and that the rejection of Applicant's claims should be withdrawn.

III. New Claims

As identified above, claims 29-34 have been added into the application through this Response. Applicant respectfully submits that these new claims describe an

invention novel and unobvious in view of the cited art of record and, therefore, respectfully requests that these claims be held to be allowable.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

11-10-04

Mary Meegan

Signature